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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,010	06/07/2001	Mahito Shinohara	35.C15623	9261

5514 7590 01/13/2004

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NEW YORK, NY 10112

EXAMINER

BROCK II, PAUL E

ART UNIT	PAPER NUMBER
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2815

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,010

Applicant(s)

SHINOHARA, MAHITO

Examiner

Paul E Brock II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear where in the originally filed disclosure support for “a semiconductor region of one conductivity type forming a resistor,” “a well forming a resistor of a conductivity type opposite to the conductivity type of the semiconductor substrate,” and “said plurality of independent potential supply portions being connected to each other through said semiconductor region forming the resistor” can be found. While the applicant cites figures 3 and 5, and lines 19 – 22 on page 20 of the originally filed specification as support for these limitations, it should be noted that there is no mention of the well (18) being used as the resistor (27). Instead the originally filed disclosure, on page 20, lines 19-22, describes a resistor region (27) formed in the well region (18). Therefore, the well region (18) does not act independently as the resistor (27) between the potential supply regions (12 and 14).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sauer (USPAT 4139784).

With regard to claim 1, as far as the examiner can ascertain, Sauer discloses in figure 7 a semiconductor region (N-TYPE Si) of one conductivity type forming a resistor. Sauer discloses in figure 7a charge transfer region (87a) of a conductivity type opposite to the conductivity type of the semiconductor region that is formed in the semiconductor region and joined to the semiconductor region to form a diode. Sauer discloses in figure 7 a signal charge input portion (85a) adapted to input a signal charge to the charge transfer region. Sauer discloses in figure 7 a signal charge output portion adapted to accumulate the signal charge transferred from the charge transfer region. Sauer discloses in figure 7a plurality of independent potential supply portions (V_s and V_c) adapted to supply a potential gradient to the semiconductor region, the plurality of independent potential supply portions supplying the semiconductor region with respectively different potentials. As far as the examiner can ascertain Sauer discloses in figure 7 that the plurality of independent potential supply portions are connected to each other through said semiconductor region forming the resistor, wherein the charge transfer region is completely depleted before the signal charge is input. It should be noted that the limitation “wherein the

charge transfer region is completely depleted before the signal charge is input” is an intended use and/or a method of using recitation which bears no patentable weight on the device claim. Sauer discloses in figure 7 wherein the signal charge in the transfer region is transferred by the potential gradient formed by the plurality of potential supply portions. Sauer discloses in figure 7 wherein the signal charge in the charge transfer region is transferred by drift over all of the charge transfer region.

Claim 4 is applied to Sauer similar to claim 1 wherein the semiconductor substrate is one conductivity type and the semiconductor region of claim 1 is the same as the well of claim 4 of the second conductivity type.

With regard to claims 3 and 6, Sauer discloses in figure 7 wherein the charge transfer region is buried in the semiconductor region (well) and forms a buried diode together with the semiconductor region.

Response to Arguments

5. Applicant's arguments filed April 28, 2003 have been fully considered but they are not persuasive.

6. With regard to applicant's explanation of how the semiconductor region of one conductivity type (i.e. well region 18) forms a resistor, it should be noted that the only description of a resistor found in the originally filed specification would not lead one of ordinary skill in the art to believe that the well region (18) alone acts as the resistor (27) between regions

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12 and 14. Arguments do not replace subject matter which has been originally disclosed in the written description. Nor should the arguments be relied upon to fill a void which has been left questionable by the originally filed disclosure. Therefore, applicant's arguments are not persuasive and the rejection is proper.

7. In response to applicant's argument that "wherein the charge transfer region is completely depleted before the signal charge is input," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the charge transfer region is intended to be "completely depleted before the signal charge is input". Therefore, the applicant's arguments are not persuasive, and the rejection is proper.

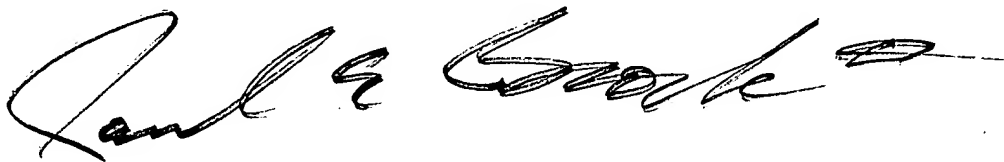
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E Brock II whose telephone number is (703) 308-6236. The examiner can normally be reached on 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (703) 308-2772. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Paul E Brock II

A handwritten signature in black ink, appearing to read "Paul E Brock II", with a stylized flourish at the end.